REMARKS

Claims 5-8 and 10-16 are pending in this application. By this Amendment, claims 5-8, 11 and 14 are amended. Support for the amendments to the claims may be found, for example, in the specification at pages 5-10. No new matter is added.

The courtesies extended to Applicant's representative by Examiner Vo at the interview held November 4, are appreciated. The reasons presented at the interview as warranting favorable action are incorporated into the remarks below, which constitute Applicants' separate record of the interview.

In view of the foregoing amendments and following remarks, reconsideration of the rejections and allowance of the application are respectfully requested.

I. Rejection Under 35 U.S.C. §112

The Office Action rejects claims 5-8 and 10-16 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter that Applicants regard as the invention. Applicants respectfully traverse the rejection.

Specifically, the Office Action asserts that the features "instruction form" and "storage part" are ambiguous. During the personal interview, the Examiner stated that these features, without more description, could read on any number of objects. For example, the Examiner asserted that the instruction form could be anything from an XML document to a piece of paper, and the storage part could be anything from computer memory to a file cabinet or the like.

The test for compliance with 35 U.S.C. §112, second paragraph, is whether one skilled in the art would understand the bounds of the claims when read in light of the specification. *Miles Lab., Inc. v. Shandon Inc.,* 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993), *cert. denied,* 510 U.S. 1100 (1994). If the claims, read in light of the specification, reasonably apprise those skilled in the art of the scope of the invention, Section

112 demands no more. *See, also, In re Merat,* 519 F.2d 1390, 1396, 186 USPQ 471, 476 (CCPA 1975), which stated that the question under Section 112, second paragraph, is whether the claim language, when read by a person of ordinary skill in the art in light of the specification, describes the subject matter with sufficient precision that the bounds of the claimed subject matter are distinct. *See, also, In re Warmerdam,* 33 F3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

By this Amendment, the independent claims are amended to recite that a computer comprises an instruction form management apparatus or that an instruction form management system comprises a computer comprising an instruction form management apparatus. Additionally, the instruction form is described in the independent claims as "an instruction form that causes a process to be executed to a document by at least one of a plurality of instruction form execution apparatus." Further, the amended independent claims recite that a computer comprises the instruction form management apparatus and the instruction form management apparatus comprises both the "instruction form" and "storage part." Therefore, the "instruction form" and the "storage part" are both comprised within a computer.

In light of the amendments to the independent claims, Applicants respectfully assert that one of ordinary skill in the art would understand the bounds of an "instruction form" and "storage part" that are comprised within a computer. Put differently, one of ordinary skill in the art would understand the bounds of "an instruction form that causes a process to be executed to a document by at least one of a plurality of instruction form execution apparatus" and a "storage part" that stores the instruction form, when read in light of the amended independent claims that recite that these elements are comprised within a computer. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

II.   Rejection Under 35 U.S.C. §101

The Office Action rejects claims 5-8 and 10-16 under 35 U.S.C. §101 as being directed to non-statutory subject matter. Specifically, the Office Action asserts that there are no features in the claims that link the claims to a hardware element. Applicants respectfully traverse the rejection.

MPEP §2106.01(I) states "[w]hen a computer program is recited in conjunction with a physical structure, such as a computer memory, USPTO personnel should treat the claim as a product claim." In such cases, the claim remains statutory irrespective of the fact that a computer program may be included in the claim. In other words, merely because aspects of a claim could be embodied by a computer program, does not render the overall claim non-statutory.

By this Amendment, the independent claims are amended to recite that <u>a computer comprises</u> an instruction form management apparatus or that an instruction form management system <u>comprises a computer</u> comprising an instruction form management apparatus. Therefore, Applicants respectfully assert that the independent claims link to a hardware element at least because of the above recitations, as well as for the other statutory features that they recite. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

III.   Rejection Under 35 U.S.C. §102

The Office Action rejects claims 5-8 and 10-16 under 35 U.S.C. §102(b) over "Oracle9l Case Studies - XML Applications," June 2001 by Oracle ("Oracle"). Applicants respectfully traverse the rejection.

By this Amendment, claim 5 recites, "... the instruction form management apparatus gives a control function to at least one instruction form execution apparatus to execute a process indicated on the instruction form, and the at least one instruction form execution

apparatus returns the control function to the instruction form management apparatus once the instruction form execution apparatus completes the process indicated on the instruction form." Claims 8, 11 and 14 recite similar features. Oracle fails to teach an instruction form management apparatus or system as claimed.

Oracle merely discloses a system that allows a user to fill in an order form that is then output to a supplier after the user clicks on "Place Order" (see, e.g., Fig. 8-5). Oracle further teaches that once the order form is output to the supplier, the data that was entered into the form is deleted (see, e.g., Fig. 8-5). However, nowhere does Oracle disclose that an instruction form management apparatus sends a control function to an execution apparatus according to the process indicated on an instruction form, and then receives a control function from the execution apparatus once the execution apparatus completes the process indicated on the instruction form. This feature allows a central instruction form management apparatus to control the execution of the process indicated on an instruction form without requiring additional user input, which is not disclosed in Oracle. Therefore, Oracle fails to teach each and every feature of amended claims 5, 8, 11 and 14.

Claims 5, 8, 11 and 14 are not anticipated by Oracle. Claims 6, 7, 10, 12, 13, 15 and 16 variously depend from claims 5, 8, 11 and 14 and, thus, also are not anticipated by Oracle. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

IV.   Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

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